PATENT
Attorney Docket No. 10587.0367-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Scott K. BROWN et al.	)	Group Art Unit: 2445
	)	
Application No.: 10/697,804	)	Examiner: Jeffrey R. SWEARINGEN
	)	
Filed: October 31, 2003	)	
	)	
For: MANAGING ACCESS TO DIGITAL CONTENT SOURCES	)	Confirmation No.: 1159

Mail Stop: Pre-Appeal
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commiussioner:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the Final Office Action mailed on January 20, 2012, the period for response to which extends through April 20, 2012. This Request is being filed concurrently with a Notice of Appeal.

Applicants have met each of the requirements for a pre-appeal brief review of the rejection set forth in the Final Office Action. The application has been at least twice rejected. Applicants have filed a Notice of Appeal with this Request, and has not yet filed an Appeal Brief. The remarks of this Pre-Appeal Brief Request for Review is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejection. *See* Official Gazette Notice, July 12, 2005.

Therefore, Applicants request reconsideration and withdrawal of the final rejections for the following reasons.

REMARKS

I. Status Of The Claims

In the Final Office Action of January 20, 2012 ("the Final Office Action"), the Examiner: rejected claims 1-8, 10-16, 18-26, 28-34, and 36 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,003,030 to Kenner et al. ("*Kenner*"); rejected claims 9 and 27 under 35 U.S.C. § 103(a) as being unpatentable over *Kenner* in view of U.S. Patent No. 6,377,996 to Lumelsky et al. ("*Lumelsky*"); and rejected claims 17 and 35 under 35 U.S.C. § 103(a) as being unpatentable over *Kenner* in view of U.S. Patent No. 7,076,552 to Mandato ("*Mandato*").

Applicants respectfully traverse the rejections and submit that the pending claims are allowable over the prior art of record for at least the following reasons.

II. Rejection Under 35 U.S.C. § 102(b) Based On *Kenner*

Applicants respectfully traverse the rejection of claims 1-8, 10-16, 18-26, 28-34, and 36 as being anticipated by *Kenner*. *Kenner* fails to anticipate each and every element of Applicants' claims.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *see also* M.P.E.P. § 2131. In this case, independent claims 1 and 19 recite features that *Kenner* fails to disclose. Accordingly, the rejection is improper and should be withdrawn.

For example, in ¶ 3-9 of the Final Office Action, the Examiner attempts to compare the claimed "SM" parameter of *Kenner* to the "gist" or "trust" of Applicants'

performance metric. Distilling an invention to a "gist" or "trust" is inappropriate, even under the more lenient obviousness standard. *See* M.P.E.P. § 2141.02. Moreover, the rejection of the claims is legally deficient because it ignores several elements of the claims, such as the requirements that the performance metric is "measured by the client between each of the at least two of the content sources," "compar[ed with] the performance metrics for the content sources," and "based on requesting the identical portions of the content [requested from each of the content sources in the list of the content sources]," as recited in claim 1.

The Final Office Action fails to point to any section of *Kenner* that discloses or teaches that the "SM" parameter of *Kenner* is measured by the client between each of the at least two of the content sources, compared with the "SM" parameters for the content sources, or is determined based on requesting the identical portions of the content requested from each of the content sources in the list of the content sources. Rather, the Final Office Action merely asserts that the presence of the "SM" parameter indicates that the clip is enabled for Smart Mirror. This does not support the allegation that "[t]he 'SM' parameter is determined **upon** requesting content." Even if this were correct, this does not teach **any** of the aforementioned features of Applicants' claims.

For example, determining the 'SM' parameter **upon** requesting content does not disclose that the 'SM' parameter is **measured** by the client **between each of the at least two of the content sources**. Determining the 'SM' parameter **upon** requesting content also does not disclose that the 'SM' parameter is **compared** for the content sources. Determining the 'SM' parameter **upon** requesting content also does not

disclose that the 'SM' parameter is **based on** requesting the identical portions of the content requested from each of the content sources in the list of the content sources.

In view of the foregoing, *Kenner* fails to anticipate each and every element of independent claim 1. As such, the rejection of claim 1 is improper and should be withdrawn. Independent claim 19, while different in scope, recites similar features to that noted above for claim 1 and, therefore, is also allowable over *Kenner*.

Claims 2-8, 10-16, 18, 20-26, 28-34, and 36 depend from one of the independent claims and also recite additional distinguishing features. Accordingly, the rejection of the dependent claims is improper and should be withdrawn.

III. Rejection Under 35 U.S.C. § 103(a) Based On *Kenner* and *Lumelsky*

Applicants traverse the rejection of claims 9 and 27 as being obvious over the combination of *Kenner* and *Lumelsky*. A *prima facie* case of obviousness has not been established.

Claims 9 and 27, in addition to reciting additional distinguishing features, depend from one of independent claims 1 and 19. As noted above, *Kenner* fails to disclose, and does not suggest, the claimed "determining" and other features of claims 1 and 19. The Final Office Action does not rely upon *Lumelsky* to cure these deficiencies, and *Lumelsky* does not disclose these elements.

Accordingly, the Final Office Action has failed to present a *prima facie* case of obviousness with respect to claims 9 and 27, and the rejection of the claims under 35 U.S.C. § 103(a) should be withdrawn.

IV. Rejections Under 35 U.S.C. § 103(a) Based On *Kenner* and *Mandato*

Applicants traverse the rejection of claims 17 and 35 as being obvious over the combination of *Kenner* and *Mandato*. A *prima facie* case of obviousness has not been established with respect to claims 17 and 35.

Claims 17 and 35, in addition to reciting additional distinguishing features, depend from one of independent claims 1 and 19. As noted above, *Kenner* fails to disclose, and does not suggest, the claimed "determining" and other features of claims 1 and 19. The Final Office Action does not rely upon *Mandato* to cure these deficiencies, and *Mandato* does not disclose these elements.

Accordingly, the Final Office Action has failed to present a *prima facie* case of obviousness with respect to claims 17 and 35, and the rejection should be withdrawn.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: April 20, 2012

By: /C. Gregory Gramenopoulos/
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